

#1/Reg. for Reconsideration
Hawkins
8/23/02

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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In re application of

Docket No: Q66775 1

Yoshihito ASAO, et al.

Appln. No.: 09/978,548

Group Art Unit: 2834

Confirmation No.: 5255

Examiner: Tran N. NGUYEN

Filed: October 18, 2001

For: ALTERNATOR AND METHOD OF MANUFACTURE THEREFOR

REQUEST FOR RECONSIDERATION

Commissioner for Patents
Washington, D.C. 20231

Sir:

In response to the Office Action dated July 17, 2002, reconsideration and allowance of the subject application are respectfully requested. Claims 11-21 are all the claims pending in the application.

In the Office Action, the Examiner set forth a Restriction Requirement, wherein the Examiner asserts new claims 11-21 (added in the Amendment filed May 28, 2002) are directed to an invention that is independent or distinct from the invention originally claimed in claims 2-10 (canceled in the Amendment filed May 28, 2002). In particular, the Examiner asserts claims 2-10 are product-by-process claims directed the structure of the alternator and the method of manufacturing the alternator, and new claims 11-21 are method claims directed to a method of manufacturing a stator of an alternator. The Examiner therefore maintains claims 11-21 are withdrawn from consideration as being directed to a non-elected invention since the invention of

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original claims 2-10 was constructively elected by original presentation for prosecution on the merits.

Applicant respectfully submits the Restriction Requirement is improper because both original claims 2-10 and new claims 11-21 are method claims directed to the same invention.

The present application is a Divisional Application under 35 U.S.C. § 1.53(b) of parent Application No. 09/624,222 and was filed in response to a Restriction Requirement dated September 25, 2001 therein. Parent Application No. 09/624,222 was originally filed with claims 1-10, wherein independent claim 1 recited "An alternator ..." and claims 2-10 recited a "A method of manufacturing the alternator according to claim 1" In the Restriction Requirement dated September 25, 2001 in parent Application No. 09/624,222, the Examiner stated claim 1 and claims 2-10 are directed to distinct invention because "claim 1 is drawn to [a] structure of a stator winding assembly used in an electric motor, classified in class 310, subclass 179" and "claims 2-10 are drawn to [a] **method of making a stator winding assembly**, classified in class 29, subclass 596" (emphasis added). In response to the Restriction Requirement, the present application was filed along with a preliminary amendment, wherein claim 1 was canceled and claim 2 was rewritten in independent form. In the Amendment filed May 28, 2002, Applicant replaced claims 2-10 with new claims 11-21 in order to more clearly recite the method of the present invention. However, in the present Restriction Requirement, the Examiner now indicates original claims 2-10 are drawn to "a structural alternator apparatus ... which [has] been considered as [a] product-by process claimed invention", and new "[c]laims 11-21 are drawn to [a] method of manufacturing the stator of an alternator ... classified in class 29, subclass 596",

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similar to the Examiner's initial characterization of claims 2-10 in the Restriction Requirement dated September 25, 2001 in parent Application No. 09/624,222.

Although original claims 2-10 (as amended by the Preliminary Amendment filed October 18, 2001) may appear at first glance to be product-by-process claims in that the claims initially recite the elements of the alternator and then recite the method for manufacturing the alternator, Applicant respectfully submits original claims 2-10 (as amended by the Preliminary Amendment filed October 18, 2001) are not product-by-process claims but rather are method claims wherein the structure of the alternator recited in the beginning of the claims is merely a statement of purpose or use forming a preamble which may or may not be given patentable weight. In particular, independent claim 2 begins with the phrase "In an alternator having" (rather than, for example, "an alternator comprising"), thereby indicating the claimed method is intended to be used for manufacturing a particular type of alternator. Further, in the Preliminary Amendment filed October 18, 2001, independent claim 2 was purposely amended to recite the elements of the alternator without using the legally defined transitional phrases of "comprising", "consisting of", "consisting essentially of", or "including". Rather, claim 2 utilizes the transitional phrase "having" so as to indicate the elements of the alternator are included in the preamble defining the intended use or purpose of the claimed method. In addition, dependent claims 3-10 (which directly or indirectly depend from claim 2) each recite "The method according to claim ...", thereby further supporting Applicant's position that independent claim 2 is a method claim. Accordingly, Applicant respectfully submits claims 2-10 are method claims since claim 2 does

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not define the claimed product in terms of the process which it is made (i.e., a product-by-process claim) but rather defines the process for making a product (i.e. a method claim).

Lastly, although Applicant agrees with the Examiner's statement that "applicant has received an action on the merits for the originally presented invention" (made in support of the Examiner's position that the invention of claims 2-10 have been constructively elected), Applicant notes that the only prior art rejections in the Office Action dated February 27, 2002 were improper double patenting rejections based on parent Application No. 09/624,222. Accordingly, Applicant submits that the claim amendments in the Amendment filed May 28, 2002 were simply made to further clarify the claimed invention rather than distinguish the claims from cited references.

In view of the above, the Examiner is respectfully requested to withdraw the Restriction Requirement and examine claims 11-21 on the merits.

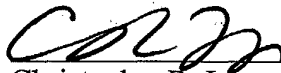
If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

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The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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